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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,643	07/22/2003	Hiroyuki Kobayashi	P23820	5185
7055	7590	01/18/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			FLANAGAN, BEVERLY MEINDL	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,643

Applicant(s)

KOBAYASHI ET AL.

Examiner

Beverly M. Flanagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-34 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 13 is/are rejected.
- 7) ☒ Claim(s) 6-12 and 14-20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


BEVERLY M. FLANAGAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/5/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Applicant's arguments filed with the election of November 12, 2004 are persuasive. Accordingly, claims 1-34 are rejoined and have been examined on the merits.

Information Disclosure Statement

The information disclosure statement filed November 5, 2003 has been made of record and the references cited therein have been considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, the "engagement hole having a narrow opening" is not positively recited. It is included in the preamble of the claim, so that the recitation of "said engagement hole" later in the claim lacks antecedent basis. In claim 20, the recitation of "said cable" and "said plate-like member" lack proper antecedent basis in the claim. It appears as though claim 20 should depend from claim 17. As claims 15-20 depend from claim 14, they are likewise rejected.

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Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Iddan et al. (U.S. Patent No. 6,632,171).

In regard to claims 1, 3 and 13, Iddan et al. teach an endoscope 10 having a ring clamp 14 with retractable supports 16 that holds in place a capsule 12 where retractable supports 16 are moveable within a bore 18 for deploying the capsule 12 (see Figures 1-3 and col. 3, lines 14-35). **In regard to claim 2**, Iddan et al. teach an alternate embodiment where a sheath 40 having a cable 44 is inserted in the forceps or working channel of the endoscope 10 and a clamp 30 holds the capsule 12 for release (see Figure 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iddan et al. (U.S. Patent No. 6,632,171) in view of Ueda et al. (U.S. Patent No. 5,681,260).

In regard to claim 4, Iddan et al. do not disclose the specifics of the capsule 12, but instead refer to U.S. Patent No. 5,604,531 as an example of the type of capsule 12 contemplated for use with the endoscope 10. Ueda et al. disclose a similar capsule endoscope 150 having a CCD 153, a driving circuit 156 driving the CCD 153 and an LED 154, a transmitting and receiving part 157 transmitting and receiving the output signal of the CCD 153, a controlling apparatus 160 arranged outside the body a battery part 158, a transmitting and receiving part 161 on the controlling apparatus 160, an operating means 162, a signal processing circuit 163 and a TV monitor 7 (see Figure 27 and col. 18, lines 9-38). Ueda et al. thus demonstrate that capsule endoscopes having the above characteristics are well known in the art. Since Iddan et al. teach the use of any suitable capsule endoscope (by referring to a patented endoscope), it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize the capsule endoscope 150 of Ueda et al. with the endoscope 10 and deployment mechanism of Iddan et al.

Allowable Subject Matter

Claims 6-12 and 15-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 21-34 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or fairly suggest a capsule endoscope having an engagement hole with a close end, where the engagement hole is provided with external terminals, as recited in independent claims 21 and 25 of the instant invention. Iddan et al. represents the most relevant prior art and the ring clamp 14 and clamp 30 of Iddan et al. do not attach to an engagement hole in the capsule 12 (see the above rejections). Accordingly, claims 21-34 are allowable over the prior art.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should note the following prior art reference disclosing a deployable capsule-type device: Pylant, U.S. Patent No. 5,860,916.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (571) 272-4766. The examiner can normally be reached on Mondays, Wednesdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Beverly M. Flanagan
Primary Examiner
Art Unit 3739
